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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/838,983	04/20/2001	David A. Hughes	SNY-P4339	1235

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MILLER PATENT SERVICES
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EXAMINER
BATURAY, ALICIA

ART UNIT	PAPER NUMBER
2155	

DATE MAILED: 04/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/838,983	HUGHES ET AL.	
	Examiner	Art Unit	
	Alicia Baturay	2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 November 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-51* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-51* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *26 November 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *03282005*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is in response to the amendment filed 11/26/2004.

2. Claims 1, 9, 17, 24, 31, 36, and 42 were amended.

3. No claims were added.

4. Claims 1-51 are pending in this Office Action.

Response to Amendment

5. The previous objections to the Drawings, Specification, and Claims have been addressed by Applicant and are withdrawn.

6. The terminal disclaimer filed on 26 November 2004 has been recorded and the double patenting rejection has been withdrawn.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.

Response to Arguments

8. Applicant's arguments, see page 13-14, filed 26 November 2004, with respect to the rejection(s) of claim(s) 1, 9, 17, 24, 36, and 42 under 35 USC § 103 have been fully considered, and the arguments regarding the "single click actuation of attachment of a predefined default audio sample" are persuasive as directed to the claims, as amended.

9. ***Applicant Arguments can be summed as follows:*** Applicant states that claims have "been amended to clarify that the attachment of the predefined audio sample is a "default" audio

sample...The original terminology was intended to embrace this, but upon review the undersigned feels that use of the term "default" may be more descriptive, without affecting the scope of the claim...Neither reference reasonably teaches or suggests a single click actuation of attachment of a default music clip attachment."

In response: Examiner appreciates the clarification of claims with respect to the use of the term "default." However, Examiner respectfully submits that this does change the scope of the claims. Using the broadest reasonable interpretation, the phrase "predefined audio sample" could be taken to mean that the sample was created before the act of attaching it to an electronic mail message. The inclusion of the word "default" and Applicant's accompanying explanation necessitate a new ground of rejection. This new reference also teaches a single click actuation of an attachment.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 1, 2, 8-10, 17, 18, 24, 25, 32, 36, 37, 41-43, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over "A guide to using MS Mail on PTOnet" (hereafter "Microsoft Mail"), Hurtado et al. (U.S. US 6,611,812), and in further view of Kelly (U.S. 6,442,595).

12. As to claim 1, Microsoft Mail discloses receiving a single command from the sender to attach a file (Microsoft Mail, page 13, top figure, note "Attach" button) and attaching the file (Microsoft Mail, page 13, top figure, note "Request.doc" file is attached). But Microsoft Mail fails to disclose a method of transmitting audio samples using electronic mail. However, Hurtado teaches that music sample tracks can be emailed between end users (Hurtado, col. 83, line 59; col. 87, lines 1-2). It would have been obvious to combine the teachings of Microsoft Mail and Hurtado to facilitate the distribution of sample music files that would lead to sources of revenue through redistribution of content (Hurtado, col. 2, line 3).

The above combination of Microsoft and Hurtado does not teach the use of a "default audio sample." However, Kelly teaches automatically attaching a file to a mail message (Kelly, col. 5, lines 12-19) where that file can be audio (Kelly, col. 6, lines 38-41). It would have been

obvious to one of ordinary skill in the art at the time the invention was made to combine Microsoft Mail-Hurtado and Kelly in order to facilitate the sending of email attachments (Kelly, col. 5, line 41-43).

13. As to claims 2, 10, 18, 25, 32, 37, 43, and 48, the combination of Microsoft Mail, Hurtado, and Kelly (Microsoft Mail-Hurtado-Kelly) discloses the invention substantially as described in claim 1, including a compressed audio sample (Hurtado, Fig. 18, #1810; col. 87, lines 1-3).

14. As to claims 8 and 41, Microsoft Mail-Hurtado-Kelly discloses the invention substantially as described in claim 1, including the single command of clicking on an icon (Microsoft Mail, page 13, top figure).

15. As to claim 9, Microsoft Mail-Hurtado-Kelly discloses the invention substantially as described in claim 1, but it does not explicitly disclose automatically attaching an audio sample to an email. Forwarding a message is a standard feature within most email programs. Additionally, when one chooses to forward a previously created email message that includes attachments, those attachments are already attached to this new email. It would have been obvious to use this forwarding feature in Microsoft Mail-Hurtado in order to facilitate the ease of use sender's spreading of the music sample and to facilitate the distribution of sample music files that would lead to sources of revenue through redistribution of content (Hurtado, col. 2, line 3).

The above combination of Microsoft and Hurtado does not teach the use of a "default audio sample." However, Kelly teaches automatically attaching a file to a mail message (Kelly, col. 5, lines 12-19) where that file can be audio (Kelly, col. 6, lines 38-41). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Microsoft Mail-Hurtado and Kelly in order to facilitate the sending of email attachments (Kelly, col. 5, line 41-43).

16. As to claim 17, claim 1 is a method performing the same functions as claim 17. Therefore paragraph 12 of this Office Action discloses all of the limitations of claim 17.

17. As to claim 24, Microsoft Mail-Hurtado-Kelly discloses the invention substantially, including attaching files to all emails. Microsoft Mail permits the use of automatic signatures, which are automatically added to the end of an outgoing email message. Microsoft Mail, as taught by the primary reference ("Microsoft Mail"), is a Windows-based email application program and can be installed in end-users' PCs that running on operating systems such as Windows 98, Windows NT etc. Use of Microsoft Mail is therefore considered general knowledge available to one of ordinary skill in the art at the time of invention because Windows 98 and Windows NT were available in the marketplace on or before 1998. It would have been obvious to adapt this feature to allow an audio file as a signature so a user could easily redistribute the file and this would lead to sources of revenue through redistribution of content (Hurtado, col. 2, line 3).

The above combination of Microsoft and Hurtado does not teach the use of a "default audio sample." However, Kelly teaches automatically attaching a file to a mail message (Kelly, col. 5, lines 12-19) where that file can be audio (Kelly, col. 6, lines 38-41). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Microsoft Mail-Hurtado and Kelly in order to facilitate the sending of email attachments (Kelly, col. 5, line 41-43).

18. As to claim 36, claim 1 is a method performing the same functions as claim 36. Therefore paragraph 12 of this Office Action discloses all of the limitations of claim 36.

19. As to claim 42, claim 9 is a method performing the same functions as claim 42. Therefore paragraph 15 of this Office Action discloses all of the limitations of claim 42.

20. Claims 3, 5, 6, 11, 13, 14, 16, 19, 21, 22, 26, 28, 29, 31, 33-35, 38-40, 44-47, and 49-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft Mail-Hurtado, Fritsch (U.S. 6,233,682), and in further view of Kelly (U.S. 6,442,595).

21. As to claims 3, 6, 11, 14, 19, 22, 26, 29, 33, 35, 38, 40, 44, 46, 49, and 51, Microsoft Mail-Hurtado discloses the invention substantially as described in claim 2, but do not explicitly teach an audio sample comprising of a link to purchase. Fritsch teaches purchase of music files over the Internet (Fritsch, col. 4, lines 58-60). The link to the source of purchase is a link to a website, and it is therefore inherent that the link comprises a URL. It would have

been obvious to one of ordinary skill at the time the invention was made to combine Microsoft Mail-Hurtado and Fritsch (Microsoft Mail-Hurtado-Fritsch) to facilitate the purchase of music online resulting in increased revenue via e-commerce (Fritsch, col. 1, lines 24-26).

22. As to claims 5, 13, 21, 28, 34, 39, 45, and 50, Microsoft Mail-Hurtado-Kelly discloses the invention substantially as described in claim 1, but do not explicitly teach a link to streaming music. Fritsch teaches clicking and listening to a song off of a website (Fritsch, col. 4, lines 49-58). Figure 1C shows a user "pre-listening" to a song on a web page; it is inherent the music is streaming. It would have been obvious to one of ordinary skill to combine Microsoft Mail-Hurtado with Fritsch to encourage the listening of samples to lead to purchase the song (Fritsch, col. 4, lines 58-60).

23. As to claim 16, Microsoft Mail-Hurtado-Kelly discloses the invention substantially as described in claim 1, but it does not explicitly indicate that a server is being used to distribute the emails. However, Fritsch describes a network-based system for distribution of musical products over a network which includes a server for processing user requests and a database for storing digitized songs (Fritsch, col. 3, lines 4-13). Microsoft Mail, as taught by the primary reference ("Microsoft Mail"), is a Windows-based email application program and can be installed in end-users' PCs that are connected to servers running on operating systems such as Windows 98, Windows NT etc. Use of a server to distribute emails, including Microsoft Mail-based emails, is therefore considered general knowledge available to one of

ordinary skill in the art at the time of invention because Windows 98 and Windows NT were available in the marketplace on or before 1998. Therefore it would have been obvious to incorporate Fritsch's server in the Microsoft Mail-Hurtado system to be able to distribute music titles to end users on a large scale, i.e., sending song samples via automatic email attachment from the server processing user requests and the database. A person of ordinary skill would be motivated in view of the Fritsch teaching that this would facilitate users easily and quickly purchasing music (Fritsch, col. 1, line 25-26).

24. As to claim 31, Microsoft Mail-Hurtado teaches an electronic mail application that can generate email messages (Microsoft Mail, page 2, bottom figure; page 6, top figure), but Microsoft Mail-Hurtado does not directly disclose a computer network, an enterprise email server or a means on the mail server to attach a file to an outbound email. However, Fritsch discloses a network-based system for distribution of musical products over the Internet that includes a server for processing user requests that is connected to a database, which stores digitized songs (Fritsch, col. 3, lines 4-13). Use of a server to distribute emails, including Microsoft Mail-based emails, is therefore considered general knowledge available to one of ordinary skill in the art at the time of invention because Windows 98 and Windows NT were available in the marketplace on or before 1998. Therefore it would have been obvious to incorporate Fritsch's server in the Microsoft Mail-Hurtado system to be able to distribute music titles to end users on a large scale, i.e., sending song samples via email attachment from the server processing user requests and the database. A person of ordinary skill would

be motivated in view of the Fritsch teaching that this would facilitate users easily and quickly purchasing music (Fritsch, col. 1, line 25-26).

The above combination of Microsoft, Hurtado, and Fritsch does not teach the use of a "default audio sample." However, Kelly teaches automatically attaching a file to a mail message (Kelly, col. 5, lines 12-19) where that file can be audio (Kelly, col. 6, lines 38-41). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Microsoft Mail-Hurtado-Fritsch and Kelly in order to facilitate the sending of email attachments (Kelly, col. 5, line 41-43).

25. As to claim 47, claim 31 is a system performing the same functions as claim 47. Therefore paragraph 24 of this Office Action discloses all of the limitations of claim 42.

26. Claims 4, 7, 12, 15, 20, 23, 27, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft Mail-Hurtado-Fritsch, Kang (U.S. 2001/0051925), and in further view of Kelly (U.S. 6,442,595).

Microsoft Mail-Hurtado-Fritsch discloses the invention substantially as described in claim 3, but does not explicitly disclose an affinity credit being awarded to the sender (Kang, paragraph 30). Kang and Hurtado both teach distribution of content via email (Kang, paragraph 29; Hurtado, col. 87, lines 1-2), and it would have been obvious to those skilled in the art at the time the invention was made to combine Kang's affinity credits with Hurtado's

distribution of samples to encourage the wide distribution and purchase of content (Kang, paragraph 29).

Conclusion

27. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Baturay whose telephone number is (571) 272-3981. The examiner can normally be reached at 7:30am - 5pm, Monday - Thursday, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alicia Baturay
March 30, 2005

HOSAIN ALAM
SUPERVISORY PATENT EXAMINER